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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,991	04/15/2004	Jeremy W. Altman	P-8022	9086

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John Cave  
Gunn & Lee, PC  
Suite 1500  
700 N. St. Mary's St.  
San Antonio, TX 78205

EXAMINER

ARK, DARREN W

ART UNIT	PAPER NUMBER
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3643

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/824,991

Applicant(s)

ALTMAN, JEREMY W.

Examiner

Darren W. Ark

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 13-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☒ Claim(s) 12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-12, drawn to a fishing lure, classified in class 43, subclass 42.13.
  - II. Claims 13-120, drawn to a method for manufacturing a fishing lure, classified in class 43, subclass 42.53.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the fishing lure can be made by another and materially different process such as inserting the at least one arm into the at least one sleeve and then securing the at least one sleeve within the opening.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

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5. During a telephone conversation with John C. Cave on Wednesday, December 01, 2004 a provisional election was made without traverse to prosecute the invention of I, claims 1-12. Affirmation of this election must be made by applicant in replying to this Office action. Claims 13-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Claim Objections***

6. Claims 1-9 are objected to because of the following informalities:

Claim 1, line 5, the term --and-- should be inserted after "opening;".

Appropriate correction is required.

7. Claim 12 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. See MPEP § 608.01(n). Accordingly, the claim has not been further treated on the merits.

### ***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 2-8, 9/2, 9/3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regard to claim 2, the term "said sleeve" lacks positive antecedent basis since "at least one sleeve" was set forth in claim 1.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-5, 9, 10, 11 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Johnson 5,400,542.

Johnson discloses a body (32); a hook (14); at least one opening (at front portion of 32); at least one sleeve (unlabelled crimp in Fig. 2) in the opening; at least one elongated arm (22) which is flexible cable wire (see col. 4, lines 27-29) and extends backwardly from the body (22 can be considered as extending backwardly since the direction of travel of the lure or particular point of reference would determine the front and back of the lure; the lure has not been particularly claimed to overcome this interpretation).

12. Claims 1, 9/1 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kaecker 5,092,073.

Kaecker discloses a body (20); a hook (21); at least one opening (31); at least one sleeve (31; see col. 2, lines 35-40) in the opening; at least one elongated arm (25).

13. Claims 1, 9/1 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Taibi 5,974,723.

Taibi discloses a body (24); a hook (20); at least one opening (top of 22); at least one sleeve (42) in the opening; at least one elongated arm (46).

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14. Claims 1, 9/1 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Boullt et al. 5,605,004.

Boullt et al. discloses a body (44); a hook (42); at least one opening (at top or forward portion of 44, 46); at least one sleeve (28) in the opening; at least one elongated arm (24, 20).

15. Claims 1, 9/1 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Davenport 1,645,644.

Davenport discloses a body (1, 2); a hook (10); at least one opening (see Fig. 3); at least one sleeve (18) in the opening; at least one elongated arm (14).

16. Claims 1, 9/1 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Phillips 4,777,758.

Phillips discloses a body (48); a hook (48a); at least one opening (in which 49 is located); at least one sleeve (49) in the opening; at least one elongated arm (39).

### ***Claim Rejections - 35 USC § 103***

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson 5,400,542 in view of Grove et al. 4,884,358.

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Johnson does not disclose a wire shank extending from the body with a spinning element swivelly connected to a distal end of the wire shank. Grove et al. discloses at least one arm (17) and a wire shank (11) with at least one spinning element (22) at one end thereof. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the wire shank and at least one spinning element of Grove et al. in the lure of Johnson in order to provide additional flashing attracting means to further draw the attention of fish.

19. Claims 2-5, 9/2, 9/3, 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taibi 5,974,723 in view of McWethy, Jr. 5,596,831.

Taibi discloses the sleeve (42) which telescopically receives the at least one arm (46) and wherein rotation is prevented therebetween by epoxy resin placed between the space remaining between the sleeve (42) and the arm (46), but does not disclose the sleeve being crimped to secure the at least one arm. McWethy, Jr. discloses a sleeve (28) crimped to secure an arm (wire leader 24) within the sleeve to prevent rotation therebetween. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the sleeve of Taibi such that it is crimped to secure the at least one arm in view of McWethy, Jr. in order to provide means for more quickly securing the arm that does not require the necessary time for curing of the epoxy.

In regard to claim 5, Taibi discloses at least one spinning element (56, 64).

20. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taibi 5,974,723 in view of McWethy, Jr. 5,596,831 as applied to claims 5, 10 above, and further in view of Morlen, I 2004/0074134.

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Taibi and McWethy, Jr. disclose a wire shank (of 20) extending into and from the body (22), but do not disclose a spinning element swivelly connected to the distal end of the shank. Morlen, I discloses a spinning element (73) swivelly connected (via 74) to the distal end of the shank (48, 50). It would have been obvious to a person of ordinary skill in the art to modify the shank of Taibi and McWethy, Jr. such that it has a spinning element on an end of the shank in view of Morlen, I in order to provide additional attracting means for enticing fish to strike the lure.

21. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Taibi 5,974,723 in view of McWethy, Jr. 5,596,831 as applied to claim 10 above, and further in view of Storey 5,983,554.

Taibi and McWethy, Jr. disclose the arm being wire, but do not disclose the at least one arm being flexible cable wire. Storey discloses that the weedguard (26, 29-32) can be made of wire cable or twisted wire strands. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to substitute the wire of Taibi and McWethy, Jr. with the cable wire of Storey in order to provide a weed guard material with a different degree of flexibility to suit the requirements in the type of cover to be fished.

22. Claims 2-5, 9/2, 9/3, 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boult et al. 5,605,004 in view of McWethy, Jr. 5,596,831.

Boult et al. discloses the sleeve (28) which telescopically receives the at least one arm (20, 24, 26) and wherein twist is prevented therebetween by epoxy resin placed between the space remaining between the sleeve (28) and the arm (24), but



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does not disclose the sleeve being crimped to secure the at least one arm. McWethy, Jr. discloses a sleeve (28) crimped to secure an arm (wire leader 24) within the sleeve to prevent rotation therebetween. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the sleeve of Boullt et al. such that it is crimped to secure the at least one arm in view of McWethy, Jr. in order to provide means for more quickly securing the arm that does not require the necessary time for curing of the epoxy.

In regard to claim 5, Boullt et al. discloses at least one spinning element (58).

23. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boullt et al. 5,605,004 in view of McWethy, Jr. 5,596,831 as applied to claims 5, 10 above, and further in view of Morlen, I 2004/0074134.

Boullt et al. and McWethy, Jr. disclose a wire shank (of 42) extending into and from the body (44), but do not disclose a spinning element swivelly connected to the distal end of the shank. Morlen, I discloses a spinning element (73) swivelly connected (via 74) to the distal end of the shank (48, 50). It would have been obvious to a person of ordinary skill in the art to modify the shank of Boullt et al. and McWethy, Jr. such that it has a spinning element on an end of the shank in view of Morlen, I in order to provide additional attracting means for enticing fish to strike the lure.

24. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Taibi 5,974,723 in view of McWethy, Jr. 5,596,831 as applied to claim 10 above, and further in view of Gentry 4,901,470 or Pingel 4,815,233.


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Taibi and McWethy, Jr. disclose the arm being wire, but do not disclose the at least one arm being flexible cable wire. Gentry and Pingle disclose at least one arm (52 OR 12, see col. 5, lines 1-25) made of wire cable. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to substitute the wire of Taibi and McWethy, Jr. with the cable wire of Gentry or Pingle in order to provide an arm that will flex as desired when moving through the water.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darren W. Ark whose telephone number is (703) 305-3733. The examiner can normally be reached on M-Th, 8:00am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Poon can be reached on (703) 308-2574. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Darren W. Ark  
Primary Examiner  
Art Unit 3643

DWA